IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant	: Gerald Hewes, et al.	Examiner:	Recek, Jason D.
Appl. No.	: 10/521,507	TC/A.U.:	2142
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REPLY BRIEF TO EXAMINER'S ANSWER UNDER 37 C.F.R. § 41.41

The Appellant hereby submits this Reply Brief in support of their appeal from a

Final Rejection of the Examiner, dated December 26, 2007, in the above-referenced

application. This Reply Brief addresses the Examiner's Answer mailed on August 6,

2008, in response to Appellant's Appeal to the Board of Patent Appeals and

Interferences. The Reply Brief is hereby submitted pursuant to 37 C.F.R. §41.41.

<u>**ARGUMENTS**</u>

I.   Claim 1 is Not Anticipated by Caswell.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim" (*Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)) and "the elements must be arranged as required by the claim" (*In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). The Appellants respectfully submit that Caswell fails to disclose each and every element of the invention as claimed.

As discussed in Appellants' prior Appeal Brief, claim 1 is directed to a system that assists organizations in developing, testing, deploying, and analyzing messaging systems in an integrated and scalable fashion (Specification, abstract, paragraph 0036-0052). In particular, claim 1 recites in part a "system for organizations to develop, test, execute and analyze messaging programs defining a message application server comprising: (a) a dialog designer configured to provide a user interface to an organization's program designer and marketer, to allow for rapid messaging program creation, to provide the ability to select a type of messaging program, to select a service address for the messaging program, to schedule the messaging program for execution, to upload messaging user data into lists, to create segments, to download messaging program result data, to test the messaging program, to provide reports, including real-time reports, on the messaging program."

Appellants respectfully renew their contention that Caswell fails to disclose each and every limitation as claimed.

In asserting how Caswell describes the claimed features, the Examiner states that Caswell describes a "Read Mail" service, which is a messaging program (Examiner's Answer, mailed 8/6/08, page 20 *citing* Caswell, column 5, lines 45-57).

Then, because the read mail service is interpretable as a messaging program, "Caswell does teach a 'dialog designer' that allows for the creation of a 'messaging program' (Examiner's Answer, mailed 8/6/08, page 21). Appellants respectfully disagree with this interpretation.

Rather, with reference to a "Mail Service" Caswell merely discusses that one generic network service that may be modeled by the system of Caswell is an email service (Caswell, column 5, lines 45-49). In particular, Caswell states:

> A first phase in constructing a service model is the generation of a specification of a service model template 34. The <u>service model template is a generic specification of the service topology and measurement topology for the service of interest (e.g., Read Mail service). Depending on the service being modeled and the service elements that are likely to be involved, the template defines nodes of various types (e.g., hosts, servers, network links, and services) and their associated measurements.</u> Moreover, the template indicates the dependencies among the nodes, such as the dependency of the service on other services (e.g., the Read Mail service which refers to a subscriber accessing his/her mailbox depends on the authentication and NFS services). <u>In the preferred embodiment, the template also includes default state computation rules for specified nodes, so that the state (i.e., "health") of a node can be computed based upon measurements associated with the node and upon states of dependencies of the node.</u>

(Emphasis Added)

Thus, Caswell describes a generic map of a type of network service. Ultimately, the model is used to monitor the state (i.e., "health") of various network elements in the network model. However, the concept of <u>developing, testing, and executing messaging programs</u>, where users will be enabled to message each other via the messaging programs, is completely absent from Caswell.

Simply creating and displaying a topographical map of an existing network, as disclosed in Caswell, fails to teach "a dialog designer configured to provide a user interface ... to allow for rapid messaging program creation, to provide the ability to select a type of messaging program ... to schedule the messaging program for execution ... to test the messaging program, to provide reports ... on the messaging program," as claimed.

Thus Caswell must fail to teach "each and every element as set forth in the claim," as required under 35 U.S.C. § 102. Appellants respectfully submit that claim 1, and the claims that depend therefrom, are not anticipated by Caswell.

II. Claim 18 is Not Anticipated by Gilchrist.

In order for Gilchrist to anticipate claim 18, "each and every element in the claim" must be found in Gilchrist "in as complete detail as is contained in the ... claim." (*See Verdegaal*, 814 F.2d 628, 63; *Richardson*, 868 F.2d 1236). Appellants respectfully renew their contention that Gilchrist fails to disclose each and every element of the invention as claimed.

The Examiner emphasizes that Gilchrist's discussion of a framework may be interpreted as a type of program by emphasizing specific passages, which are different than the passages noted by the Appellants in their Appeal Brief (Examiner's Answer, mailed 8/6/08, pages 22-23). Furthermore, that program may be used to develop, execute, and test those messaging programs (Examiner's Answer, mailed 8/6/08, pages 22-23). Appellants respectfully disagree.

The Examiner's discussion of how certain sections of Gilchrist may be emphasized to show that the framework is a messaging program, is an interpretation beyond the explicit teachings of Gilchrist, and as would be understood by one of ordinary skill in the art. Gilchrist provides an "object oriented mail server framework mechanism" that provides a "structure that can be placed on any OOP platform" to support common messaging systems (Gilchrist, Title and Abstract). Gilchrist takes great care to distinguish a "framework" from a program, as a framework is a collection of objects that address a particular type of problem (Gilchrist, column 5, line 61 to column 6, line 43). Thus, the framework discussed in Gilchrist is a set of objects and classes that embody an abstract design solution.

Claim 18, however, recites in part:

> (a) an organization's program designer designing the messaging program;
> (b) the program designer selecting a segment for push programs;
> (c) the program designer selecting a program service address;

(d) the program designer testing the messaging program;
(e) executing the messaging program where the messaging program is either started manually or automatically at a scheduled date.

Thus, in accordance with claim 18, Appellants claim <u>an organization's program designer designing a messaging program</u>. Furthermore, <u>the messaging program is executed to support communication with messaging users interacting with the messaging program</u>. Appellants respectfully submit that Gilchrist does not teach these features.

Rather, Gilchrist merely provides the mechanism (i.e., objects, class structures, and methods) to allow one to design a program at some later time. Appellants, however, claim the actual design and execution of a messaging program. For example, an architect creates a blueprint for a house, while workers must actually assemble and construct the house. However, it would not be logical to assert that the architect's generation of a blueprint is the same as actually building a house. The same holds true for the an object oriented framework, as discussed in Gilchrist, in contrast to designing and executing a messaging program, as claimed.

Therefore, Gilchrist cannot anticipate "(a) an organization's program designer designing the messaging program; (b) the program designer selecting a segment for push programs; (c) the program designer selecting a program service address; (d) the program designer testing the messaging program; [and] (e) executing the messaging program where the messaging program is either started manually or automatically at a scheduled date," because Gilchrist fails to teach "each and every element," as claimed.

Thus, Gilchrist does not disclose each and every limitation of claim 18. Appellants respectfully renew their contention that claim 18, and the claim that depends therefrom, are not anticipated by Gilchrist.

III.   Appellants' Invention is Patentable over Caswell in view of Gilchrist

"To establish a *prima facie* case of obviousness … the prior art reference (or references when combined) must teach or suggest all the claim limitations" (MPEP 706.02(j); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). The

Appellants respectfully submit that Caswell and Gilchrist, whether taken alone or in combination, fail to disclose or suggest the invention as claimed.

a. Claim 27 is Patentable Over Caswell in View of Gilchrist

With respect to claim 27, the Examiner stated that Caswell does not teach "looking up the appropriate session context and pull messaging program based on the messaging device address and the program service address," "executing pull messaging program instructions in the dialog server upon receiving the messaging device originated message and based on the session state and context," and "routing the messaging device originated message in the message exchange to the appropriate messaging service provider, and storing any message status delivery returned by the message exchange" (Examiner's Answer, mailed 8/6/08, pages 9-10; Final Office Action, mailed 12/26/07, page 14).

The Examiner therefore relies on Gilchrist, and states "Gilchrist clearly discloses routing messages to the appropriate service provider as address resolution which results in message routing (col. 15 ln. 17 – col.16 ln.45, Fig. 11, 14)." In the passages of Gilchrist relied upon by the Examiner, as well as the remainder of Gilchrist, Gilchrist describes an Address Resolution process for a message (Gilchrist, column 15, lines 17-42; Figure 14). Gilchrist discusses that from a message address, the protocol for handling the message may be determined and the message subsequently processed according to the protocol and delivery address. As stated by Gilchrist, "[d]uring address resolution, the system resolves each destination address to a method of delivery, such as SNADS protocol, SMTP protocol, and the like" (Gilchrist, column 14, lines 20-23 [Emphasis Added]). Determining a method of delivery (e.g., a message should be delivered as an email) and delivering the message to an intended recipient, however, completely fails to teach or suggest "routing the messaging device originated message in the message exchange to the appropriate messaging service provider."

There is simply no discussion in Gilchrist of routing messages to an appropriate service provider for messages that are bound for a plurality of different service providers. Determining a message delivery protocol does not teach, and is in no way

related to, routing messages at a message exchange <u>among service providers</u>. Thus, Gilchrist fails to cure the deficiencies of Caswell.

As such, the combination of Caswell and Gilchrist does not teach or suggest each and every limitation of claim 27. Therefore, claim 27 is not obvious over the combination of references.

b. Claim 28 is Patentable Over Caswell in View of Gilchrist

Appellants respectfully renew their contentions that a combination of Caswell and Gilchrist fail to teach or suggest "wherein the client system is configured to interface with the message application server to enable the client system to develop, analyze, test, deploy, and monitor messaging applications, the messaging applications to generate messages, receive messages from and send messages to the message service provider system," for at least the reasons discussed in their Appeal Brief (filed 5/27/08).

Furthermore, claim 28 recites in part 'wherein the message application server is configured to determine and <u>route the messages to the message service provider system regardless of the message service provider system's implemented messaging technology</u>" (Emphasis Added). As discussed above, with respect to claim 27, a combination of Caswell and Gilchrist fail to teach or suggest routing messages among service providers. Rather, the references at best describe determining an appropriate delivery protocol to deliver a message. Delivering a message based on a delivery protocol, however, fails to teach or suggest distinguishing one service provider from another, let alone routing messages to a service provider regardless of the <u>service provider system's implemented messaging technology</u>.

Therefore, Appellants respectfully submit that Caswell and Gilchrist, alone or in combination, fail to describe or suggest each and every limitation as claimed. Thus, Appellants respectfully submit that claim 28, and the claims that depend therefrom are not obvious in view of a combination of Caswell and Gilchrist.

IV. Claim 26 is Patentable Over Gilchrist in View of Eggleston

As discussed above, "[t]o establish a *prima facie* case of obviousness … the prior art reference (or references when combined) must teach or suggest all the claim limitations" (MPEP 706.02(j); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). The Appellants respectfully submit that Gilchrist and Eggleston, whether taken alone or in combination, fail to disclose or suggest the invention as claimed.

Gilchrist discloses an object-oriented (OO) framework for use with object-oriented programming (OOP) systems which provides a common message processing system structure that can be placed on any OOP platform (Gilchrist, Abstract), while Eggleston discloses using indices to provide flexibility in reviewing and requesting otherwise filtered data (Eggleston, Abstract; column 8, lines 48-55). The Examiner states that Gilchrist does not teach filtering out the messaging device addresses of users that have opted out (Final Office Action, mailed 12/26/07, page 24), but that "Eggleston in fact teaches filtering messages based on user selected criteria which results in the messages that are filtered not being sent (col. 9 ln. 27-31)" (Examiner's Answer, mailed 8/6/08, pages 28-29). Appellants respectfully disagree.

Eggleston describes an email system, where users may define filter criteria (Gilchrist, column 8, lines 14-37). The Examiner thus asserts that "[a]ddresses are inherent in email, therefore applicant's argument that Eggleston does not disclose 'addresses' (emphasis added by applicant) is not persuasive" (Examiner's Answer, mailed 8/6/08, page 28 *citing* Eggleston, column 9, lines 27-31 and column 3, lines 1-5). In those passages, Eggleston describes user selection of filter criteria such as message importance level, size, etc. None of the categories, however, teach or suggest filtering based on messaging device addresses.

The Examiner insists that because emails inherently have addresses, then Eggleston must filter addresses (Examiner's Answer, mailed 8/6/08, page 28). However, Appellants respectfully point out that Appellants claim "filtering out the messaging device addresses," and not merely filtering out an address such as an email address. Furthermore, Appellants are unable to find where Eggleston provides for a messaging device address as a filter criterion. Rather, Eggleston only provides for

filtering based on attributes of a message, such as the message priority, date, size, author, etc. (Eggleston, Figures 5 and 6).

Therefore, Eggleston fails to cure the deficiencies of Gilchrist, and a combination of Gilchrist and Eggleston fail to teach or suggest each and every limitation of claim 26. Thus, Appellants respectfully renew their contentions that claim 26 is not obvious in view of Gilchrist and Eggleston.

CONCLUSION

Appellant contends that all claims are in condition for allowance and renews all contentions recited in the Appellant's Appeal Brief. Appellant contends that the claims are patentable in light of the combination of Caswell and Gilchrist and further in light of Eggleston, Tucciarone and Dattatri. Therefore Appellant respectfully submits that the references alone or in combination do not teach, disclose, or make obvious Appellant's claimed invention. Appellant respectfully prays for reversal of the Examiner's rejection.

Authorization if herby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Appellant hereby requests such extension.

Respectfully submitted,

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